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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,957	05/04/2005	Khaledul M. Islam	PAT 800W-2	8092

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EXAMINER	
GOEL, DINESH K	

ART UNIT	PAPER NUMBER
4134	

NOTIFICATION DATE	DELIVERY MODE
02/20/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/533,957	ISLAM ET AL.	
	Examiner	Art Unit	
	DINESH GOEL	4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05/04/2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/28/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 7 objected to because of the following informalities: With in claim 7 number "7" has been used again erroneously. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755).

Referring to claim 1, Cooper et al teaches (paragraph 0027) in a mobile device comprising: a transceiver for exchanging information with the wireless networks; a memory; a current blacklist (Cooper et al reads Avoidance Data list) provided in the memory; and a processor for updating the current blacklist. Although Cooper et al does not teach the current blacklist identifying wireless networks that do not provide specifically packet data services to the mobile device, Hind et al teaches (paragraph 0071) such a list (reads Voice Only list) identifying wireless networks

that do not provide packet data services and uses this list to avoid those networks.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Hind et al with Cooper et al. The motivation would be to use this black list identifying wireless networks that do not provide packet data services (based on previous packet data service authentication rejections) to allow a mobile device to acquire a wireless network more efficiently for data applications (paragraph 0011 and 0013).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755) and further in view of Daly (U.S. Patent No. 6122503).

Referring to claim 2, Cooper et al further teaches (paragraph 0031) The mobile device of claim 1 wherein the current blacklist includes an element selected from the group consisting of: a system identifier and network identifier for each blacklisted wireless network; a timer value or an age timer for each blacklisted wireless network (Cooper teaches Avoidance Time). No flag indicating whether an identification of a blacklisted wireless network has been passed to a server is taught by Cooper et al, however, such a flag (reads status indicator) is taught by Daly (column 4, line 35).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Daly with the teachings of Cooper et al and Hind et al for teaching the limitation of the claim wherein the current blacklist included a flag indicating whether an identification of a blacklisted wireless network has been passed to a server for the purpose of database synchronization (mobile device and server).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755) and further in view of Yasushi et al. (U.S. Patent Publication No. 2002/0046285).

Referring to claim 3, the mobile device of claim 1 wherein the current blacklist includes a composite current blacklist received from a server. Although Cooper et al and Hind et al do not teach about a composite current blacklist, Yasushi et al teaches (Paragraph 0009)) such a composite list (data) based on the data sent to the server from various mobile devices to update the database.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Yasushi et al with the teachings of Cooper et al and Hind et al for teaching the limitation of this claim wherein the current blacklist included a composite current blacklist from the server.

5. Claim 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755).

Referring to claim 4, Cooper et al teaches (paragraph 0026) a method for a mobile device having a current blacklist comprising: detecting a wireless network; examining the current blacklist stored on the mobile device; if the detected wireless network is listed in the current blacklist, refraining from making any call attempts for a predetermined period of time (paragraph 0033). However, Cooper does not teach this with respect to data services. Hind et al teaches (Figure 5) determining whether the wireless network provides data services to the mobile device, and adding the wireless network to the current blacklist(Hind reads Voice-Only list) if the wireless network does not provide data services to the mobile device.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Hind et al with Cooper et al for teaching all the limitations of this claim wherein detecting a wireless network, examining the current blacklist stored on the mobile device, refraining from making any call attempts for a predetermined period of time(if the detected wireless network is listed in the current blacklist) are taught by Cooper

(paragraphs 0026 and 0033), and determining whether the wireless network provides data services to the mobile device, and adding the wireless network to the current blacklist if the wireless network does not provide data services to the mobile device are taught by Hind et al (Figure 5). The motivation to combine would be to improve the efficiency by preventing a mobile device from attempting to acquire wireless networks which did not provide data services.

Referring to claim5, the method of claim 4 further comprising, prior to the step of checking, the step of determining whether the wireless network supports data services, is further taught by Hind (paragraph 0072). At the time the invention was made, again, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Cooper et al and Hind et al (limitations of claim 4 already taught by this combination) for this dependent claim.

Referring to claim 6, the method of claim 4 wherein the step of determining whether the wireless network provides packet data services to the mobile device may also comprise the step of authenticating the mobile device on the wireless network, although this is not explicitly taught by Hind, it is implied (Figure 5) that the step of determining whether the wireless network provides packet data services to the mobile device may also comprise the step of authenticating the mobile device on the wireless network, which, at the time the invention was made, would have been obvious to a person of ordinary skill in the art by

combining the teachings of Hind et al (Figure 5) with the teachings of Cooper et al.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755) and further in view of Yasushi et al. (U.S. Patent Publication No. 2002/0046285) and Daly (U.S. Patent No. 6122503).

Referring to claim 7, the method of claim 4 further comprising a step selected from the group consisting of: starting an age timer associated with a wireless network that is added to the current blacklist and clearing an age timer associated with a wireless network in response to satisfaction of a reset condition are taught by Cooper et al (paragraph 33). However, the step of notifying a server of a newly blacklisted wireless network to maintain a composite blacklist is taught by Yasushi et al (paragraph 0008), and receiving a composite current blacklist from a server is taught by Daly (Column, line 5).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Yasushi et al and Daly with the teachings of Cooper et al and Hind et al for teaching the limitation of this claim for starting an age timer associated with a wireless network that is added to the current blacklist; clearing an age timer associated with a wireless network in

response to satisfaction of a reset condition, notifying a server of a newly blacklisted wireless network to maintain a composite blacklist and receiving a composite current blacklist from a server. This would allow a mobile device to have its blacklist up-to-date and in sync with the server.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755) and further in view of Marran (U.S. Patent No. 6549770).

Referring claim 8, the method of claim 4 further comprising the step of clearing the current blacklist in response to a provisioning reset condition. Marran teaches (Column 4, line 15-65; Column 5, line 1-50; Column 8, line 30-50; Column 11, line 10-45) updating or correcting data stored in a mobile station under various conditions.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Marran with the teachings of Cooper et al and Hind et al (as already described for independent claim 4) to clear the current blacklist in the mobile device in response to a provisioning reset condition.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (U.S. Patent Publication No. 2003/0129979) in view of Hind et al. (U.S. Patent Publication No. 2005/0037755) and further in view of Yasushi et al. (U.S. Patent Publication No. 2002/0046285) and Daly (U.S. Patent No. 6122503).

Referring to claim 9, a method of claim 4 further comprising a step selected from the group consisting of: sending a notification to the server if a mobile device finds a wireless network which was not previously providing packet data services to the mobile device and is now providing packet data services to the mobile device, Yasushi et al teaches (paragraph 8) a method of updating database in the server with the update condition received from various mobile units; and sending a notification from the server to other mobile devices to clear the entry of a wireless network which was previously not providing packet data services but currently is providing packet data services, Daly teaches (Column 4 line 5) such a method for updating mobile stations.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Yasushi et al and Daly et al with the teachings of Cooper et al and Hind et al (as already described for independent claim 4) to send updates from mobile device to the server and

server to other mobile devices so that all mobile devices will have the current blacklist.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann et al. (U.S. Patent No. 5642398) in view of Daly (U.S. Patent No. 6122503).

Referring to claim 10, A method of packet data service notification in a wireless network, the wireless network including a server and a mobile device, the method comprising: receiving at the server a registration of a newly powered-up mobile device; retrieving a server-stored current blacklist identifying wireless networks that do not provide packet data services to the newly powered-up mobile device; and sending the server-stored current blacklist from the server to the newly powered-up mobile device for reception by and storage on the mobile device. Tiedemann et al teaches (Column 10, line 25-67) a method of sending data from a service provider to a mobile device when a power up registration is received. Although Tiedemann et al does not teach specifically about sending a blacklist, it teaches about sending system, network, and zone information to facilitate mobile station operation across multiple systems and networks. Daly further teaches (Column 4, line 5) sending network information from server to a mobile station to update the database within the mobile station which is used to control the roaming operation.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Tiedemann et al and Daly. The motivation for this modification would be to allow a mobile device to receive the current blacklist from the server at the time of power-up registration to facilitate and control roaming operation across multiple networks (Daly Column 4, line 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DINESH GOEL whose telephone number is (571)270-5201. The examiner can normally be reached on Monday-Friday 8:00 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derrick Ferris can be reached on 571-272-3123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. G./
Examiner, Art Unit 4134

/Derrick W Ferris/

Supervisory Patent Examiner, Art Unit 4134